

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

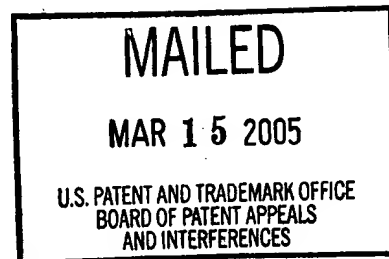
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL HANNINGTON

Appeal No. 2005-0214
Application 09/742,653

ON BRIEF



Before KRATZ, DELMENDO and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 31-33, 35-40, 42, 43, and 46-77. A copy of claims 31, 59, and 60 are appended to this decision.

The examiner has relied upon the following references as evidence of unpatentability:

Unitika Limited (Great Britain)	1,511,060	May 17, 1978
Torobin	4,582,534	Apr. 15, 1986
Calhoun et al. (Calhoun '790)	5,141,790	Aug. 25, 1992
Plamthottam et al. (Plamthottam)	5,180,635	Jan. 19, 1993
Calhoun et al. (Calhoun '178)	5,585,178	Dec. 17, 1996
Rusincovitch et al. (Rusincovitch)	5,676,787	Oct. 14, 1997

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I. Claims 31-33, 35-40, 42, 46-52, 55, and 59 stand rejected under 35 U.S.C. § 103 as being obvious over Rusincovitch.

II. Claims 31-33, 35-40, 42, 43, 46-52, 55, and 59 stand rejected under 35 U.S.C. § 103 as being unpatentable over Calhoun '790 in view of Rusincovitch.

III. Claims 47 and 48 stand rejected under 35 U.S.C. § 103 as being over Calhoun '790 in view of Rusincovitch and further in view of Plamthottam.

IV. Claims 54 and 56-58 stand rejected under 35 U.S.C. § 103 as being obvious over Calhoun '790 in view Rusincovitch and further in view of Calhoun '178.

V. Claims 60-62, 66-72 and 74 stand rejected under 35 U.S.C. § 103 as being obvious over Calhoun '790 in view of Torobin.

VI. Claims 63-65 stand rejected under 35 U.S.C. § 103 as being obvious over Calhoun '790 in view of Torobin, and further in view of British Patent 1,511,060.

VII. Claims 73 and 75-77 stand rejected under 35 U.S.C. § 103 as being obvious over Calhoun '790 in view of Torobin and further in view of Calhoun '178.

On page 4 of the brief, appellant states that the claims stand or fall together, but on pages 12-13, argues claim 60 separately. We select and confine our discussion to claims 31 and 60. See 37 CFR § 1.192(c)(7)(2003).

We have carefully reviewed appellant's brief, and reply brief, and the examiner's answer, and the evidence of record.

This review has led us to the following determinations.

OPINION

I. The 35 U.S.C. § 103 rejection of claims 31-33, 35-40, 42, 46-52, 55, and 59 as being obvious over Rusincovitch

We consider claim 31.

At the bottom of page 5 of the answer, the examiner states that the primary issue in this rejection is whether Rusincovitch suggests a pattern of non-adhesive material forms, embedded into the top release surface of the release liner, wherein the top surface of the non-adhesive material forms, is even with, or below, the plane of the top release surface of the release liner, as recited in appealed claim 31. The examiner's position for this rejection is set forth on pages 2-5 of the final Office action mailed October 27, 2003, and we refer to the position as set forth therein. We note that the examiner has modified his position in so much as to state, on page 8 of the answer, that the examiner agrees with the appellant that the method of making the product in Rusincovitch is different from appellant's process, and therefore the examiner withdraws the contention, outlined in the final rejection, that the non-adhesive forms would inherently be even with, or below, the top surface of the release liner.

Although the examiner recognizes that Rusincovitch does not inherently disclose non-adhesive forms embedded into the top release surface of the release liner, the examiner states that Rusincovitch suggests to modify the position of the non-adhesive forms such that the forms may be partially, or fully, embedded into the release liner. Answer, page 8. The examiner refers to appellant's specification, page 18, paragraph [0047], which discloses that "the non-adhesive material may be fully or partially embedded into the release liner". From this

disclosure, the examiner determines that there is no suggestion in the specification that indicates that results, such as air-egress, repositionability, and slidability, depend on the position of the non-adhesive material forms relative to the adhesive surface of the adhesive layer. Answer, page 6. The examiner also concludes that "it is functionally equivalent to place the non-adhesive forms either fully or partially embedded into the release liner". Answer, page 6.

We disagree with the examiner's aforementioned reasoning. The examiner relies upon appellant's own specification for a teaching of equivalency, rather than any teaching in Rusincovitch. This approach fails in two ways. Firstly, no teaching exists (either in appellant's disclosure or in Rusincovitch) that indicates equivalency between (1) non-adhesive material forms on the surface (as taught in Rusincovitch), (2) non-adhesive material forms partially embedded into the surface, and (3) non-adhesive material forms fully embedded into the surface. Secondly, and more importantly, the examiner cannot rely upon appellant's own teachings as guidance. Such reliance amounts to impermissible hindsight derived from appellant's own disclosure (W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)) rather than some teaching, suggestion or incentive derived from the prior art (ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir., 1984)).

On page 7 of the answer, the examiner also states that it would have been obvious to have positioned the non-adhesive material forms 18 of Rusincovitch either partially or fully embedded into the release liner 20 insofar as the desired physical properties of repositionability, air egress, and slidability are maintained. Again, the examiner relies upon

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appellant's own specification and concludes that because appellant's specification shows no difference between such properties when the non-adhesive material forms are either fully or partially embedded, it can be assumed that modifying the product of Rusincovitch in this matter will also maintain these properties. For the reasons stated in the previous paragraph, we cannot agree with this logic.

We additionally refer to page 2 of the reply brief, wherein appellant argues that Rusincovitch teaches that the non-adhesive forms are printed on the surface of the release liner. Appellant states that Figure 4B of Rusincovitch shows the non-adhesive forms are on the surface, and are not embedded into the release liner. Appellant also states that Rusincovitch further discloses, at column 6, lines 60-61, that the printed ink spacers protrude from the flat surface of the release liner. As discussed above, the examiner recognizes that Rusincovitch does not inherently disclose non-adhesive forms "embedded into" the top release surface of the release liner. The examiner relies upon appellant's own specification in an effort to conclude that Rusincovitch suggests to modify the position of the non-adhesive material forms such that they are "embedded into" the top release surface. These circumstances lead us to conclude that the examiner, in making his Section 103 rejection, has fallen victim to the insidious effect of hindsight syndrome wherein that which only the inventor has taught is used against its teacher. W.L. Gore & Assocs. V. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

In view of the above, we therefore reverse the rejection.

II. The rejection of claims 31-33, 35-40, 42, 43, 46-52, 55, and 59 under 35 U.S.C. §103 as being unpatentable over Calhoun '790 in view of Rusincovitch

Again, we limit our consideration to claim 31.

We refer to pages 5-7 of the Office action of Paper No. 18 (mailed October 27, 2003) regarding the examiner's position for this rejection.

The issue in this rejection is whether the combination of references fairly suggests to one of ordinary skill in the art that it would have been obvious to have embedded the non-adhesive forms into the top release surface of the release liner such that the non-adhesive material forms are even or below the plane of the top release surface of the release liner, wherein the the non-adhesive forms comprise a polymeric ink.

Beginning on page 5 of the final Office action of Paper No. 18, the examiner finds that Calhoun '790 shows a release liner having a top release surface and a bottom surface (in Figure 1), wherein there is a non-adhesive material embedded into the top release surface of the release liner, and refers to item 15 shown in Figure 1 of Calhoun '790. The examiner states that Calhoun '790 teaches the use of glass microspheres, rather than polymeric ink, for the non-adhesive material forms.

The examiner relies upon Rusincovitch for teaching the use of polymeric ink, and refers to column 2, lines 15-24 and column 1, lines 65 through column 2, line 2 of Rusincovitch. Final office action of Paper No. 18, page 6.

The examiner concludes that it would have been obvious to have modified Calhoun '790 by using ink forms, rather than the glass microspheres, for the purpose of providing a repositionable adhesive, wherein the non-adhesive material forms are not noticeable when viewing a substrate from the facestock surface as taught by Rusincovitch. Final office action of Paper No. 18,

page 7.

Appellant's response to the examiner's rejection begins on page 8 of the brief. On page 9 of the brief, appellant argues that Rusincovitch's solution is to print spacers on the surface of a release liner, and that Rusincovitch does not teach or suggest printing non-adhesive material forms into the surface of the release liner, and then embedding the non-adhesive material forms so that the top surface of the non-adhesive material forms is even with or below the top of the release surface of the release liner.

Appellant argues that there is no motivation provided by Rusincovitch, because (1) Rusincovitch specifically acknowledges the deficiencies of Calhoun '790, and (2) Rusincovitch's solution to the deficiencies of Calhoun '790 is to replace the spaced clumps of particles of Calhoun '790, with spacers of ink printed on the release liner. Appellant further argues that Rusincovitch fails to teach the further modification of embedding the spacers of ink into the release liner or to suggest the desirability of such a modification. Brief, page 10.

We are not convinced by such argument. We note that one cannot show nonobviousness by attacking the references individually where the rejection is based on the combined teachings of the references. As explained by the Court in In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981):

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

In the instant case, the teaching of non-adhesive material forms "embedded into" the top surface of the release liner is found in Calhoun '790. Hence, appellant's argument that Rusincovitch does not teach this aspect of the invention does not address the combined teachings of the references, and hence, is unpersuasive. Id.

While we appreciate that appellant wishes us to interpret Rusincovitch as teaching to position the non-adhesive material forms on the top surface of the release layer, rather than embedded into the top surface of the release layer, because Rusincovitch is an improvement patent over Calhoun '790, we do not agree with such logic. Rusincovitch teaches that one of the disadvantages of the prior art is that the spacer means shows through the decorative face of the wall covering. See column 1, lines 65-68 of Rusincovitch. The examiner therefore correctly relies upon this teaching as motivation to substitute the material of the particles of Calhoun '790 with the polymeric ink material of Rusincovitch, while keeping the positioning of the non-adhesive material forms as taught by Calhoun. We also note that one of the disclosed materials for the particles of Calhoun '790 can be polymeric. See column 3, lines 24-39 of Calhoun '790.

In view of the above, we affirm the rejection of claims 31-33, 35-40, 42, 43, 46-52, 55 and 59 under 35 U.S.C. § 103 as being unpatentable over Calhoun '790 in view of Rusincovitch.

III. 35 U.S.C. § 103 rejection of claims 47 and 48 as being obvious over Calhoun '790 in view of Rusincovitch, and further in view of Plamthottam

Claims 47 and 48 depend upon claim 31. We also note that on page 11 of the brief, appellant presents similar arguments for this rejection (i.e., that the applied references do not teach adhesive articles including non-adhesive material forms comprising a polymeric ink that are embedded into the release liner, even with or below, the upper surface of the release liner).

Hence, for the same reasons that we affirmed the rejection of claim 31 as being obvious under 35 U.S.C. § 103 over Calhoun '790 in view of Rusincovitch, we affirm this rejection.

IV. The 35 U.S.C. § 103 rejection of claims 54 and 56-58 as being obvious over Calhoun '790 in view of Rusincovitch and further in view of Calhoun '178

Claims 54 and 56-58 also depend upon claim 31.

Appellant presents similar arguments for this rejection, i.e., that the applied references do not cure the deficiencies of Calhoun '790 and Rusincovitch regarding an adhesive article including a non-adhesive material forms comprising a polymeric ink that are embedded into the release liner even with or below the upper surface of the release liner.

Hence, for the same reasons that we affirmed the rejection of claim 31 as being obvious under 35 U.S.C. § 103 over Calhoun '790 in view of Rusincovitch, we affirm this rejection.

V. The 35 U.S.C. § 103 rejection of claims 60-62, 66-72 and 74 as being obvious over Calhoun '790 in view of Torobin

We consider claim 60 in this rejection. Claim 60 recites, *inter alia*, "a pattern of vacuum metallized or sputtered deposits of non-adhesive material forms embedded into the release surface of the release liner, said non-adhesive material forms having a top surface."

On page 13 of the brief, appellant disputes that Torobin teaches microspheres that are vacuum metallized or sputtered. In fact, appellant asserts that the microspheres in Torobin are not vacuum metallized or sputtered; rather, the inner volume of the microspheres can contain a high vacuum produced by condensing a metal vapor, used to blow the microspheres, and refers to column 5, lines 64-68 of Torobin. Appellant states there are no teachings whatsoever of vacuum metallized or sputtered microspheres or deposits. Brief, page 13.

However, we emphasize that claim 60 recites a pattern of non-adhesive material forms. These non-adhesive material forms are vacuum metallized or sputtered deposits.

Calhoun '790 teaches that the non-adhesive material forms are particles that are uniformly distributed. See column 3, lines 11-32. Example 1 indicates that the forms are "flood coated". See column 9, lines 15-25. The resultant article of Calhoun includes non-adhesive material forms embedded into the top release layer of a release liner. See Figure 1. The material can be polymeric or metallic. See column 3, lines 30-33.

Hence, appellant's claimed article of claim 60 reads on the resultant article of Calhoun, even if the non-adhesive material forms are produced in a variety of ways (by flood coating (Calhoun) or by being vacuum metallized or sputtered (claim 60)). See In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir.

1985) ("The patentability of a product does not depend on its method of production . . . ").¹ The burden shifts to appellant to come forward with evidence that the claimed product materially differs from a prior art product. See In re Marosi, 710 F.2d 799, 803, 218 USPQ 289, 292-93 (Fed. Cir. 1983). Absent such evidence, as in the present case, we therefore affirm the rejection.

VI. The 35 U.S.C. § 103 rejection of claims 63-65 as being obvious over Calhoun '790 in view of Torobin and further in view of British patent 5,511,060

Claim 63-65 depend upon claim 60. We also note that appellant argues that claim 63-65 depend upon claim 60, and therefore include the recitation that the non-adhesive material forms comprise vacuum metallized or sputtered deposits.

For the same reasons, therefore, that we affirmed the rejection of claim 60, we also affirm this rejection.

VII. The 35 U.S.C. § 103 rejection of claims 73 and 75-77 as being obvious over Calhoun '790 in view of Torobin and further in view of Calhoun '178

Claims 73 and 75-77 depend upon claim 60. Hence, for the same reasons that we affirmed the rejection of claim 60, we affirm this rejection.

VIII. Conclusion

We **reverse** the 35 U.S.C. § 103 rejection of claims 31-33, 35-40, 42, 46-52, 55, and 59 as being obvious over Rusincovitch. However, we **affirm** all other rejections.

¹We need not discuss Torobin in this regard.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective Sept. 13, 2003; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat., Office 21 (Sept. 7, 2004)).

AFFIRMED



Peter F. Kratz)
Administrative Patent Judge)



Romulo H. Delmendo)
Administrative Patent Judge)



Beverly A. Pawlikowski)
Administrative Patent Judge)

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APPENDIX

31. An adhesive article comprising:

a release liner having a top release surface and a bottom surface;

a continuous layer of adhesive having a bottom surface and a top surface and end edges, wherein the bottom surface of the adhesive is adhered to the top release surface of the release liner; and

a pattern of non-adhesive material forms embedded into the top release surface of the release liner, said non-adhesive material forms comprising a polymeric ink and having a top surface, wherein the top surface of the non-adhesive material forms is even with or below the plane of the top release surface of the release liner.

59. An adhesive article comprising:

a release liner having a release surface and a bottom surface;

a continuous layer of adhesive having a bottom surface and a top surface and end edges, wherein the bottom surface of the adhesive is adhered to the release surface of the release liner;

a pattern of non-adhesive material forms embedded into the release surface of the release liner, wherein the non-adhesive material forms comprise a polymeric ink and wherein the top surface of the non-adhesive material forms is even with or below the plane of the release surface of the release liner; and

a facestock adhered to the top surface of the adhesive layer, wherein the thickness of the non-adhesive material forms is sufficient to result in deformation of the facestock upon application of the adhesive article to a substrate.

60. An adhesive article comprising:

a release liner having a release surface and a back surface;

a continuous layer of adhesive having a front surface and a back surface and end edges, wherein the front surface of the adhesive is adhered to the release surface of the release liner;

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and

a pattern of vacuum metalized or sputtered deposits of non-adhesive material forms embedded into the release surface of the release liner, said non-adhesive material forms having a top surface.